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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/047,262      | 01/15/2002  | Ronald A. Holland    | C43770/126119       | 4517             |

7590 06/03/2003

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EXAMINER

BOTTORFF, CHRISTOPHER

ART UNIT

PAPER NUMBER

3618

DATE MAILED: 06/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/047,262

Applicant(s)

HOLLAND, RONALD A.

Examiner

Christopher Bottorff

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 5-14, 19-21 and 26-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 15-18, 22-25 and 29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election with traverse of species I in Paper No. 4 is acknowledged. Claims 5-14, 19-21, and 26-28 are withdrawn as being drawn to a non-elected species. Of pending claims 1-29, claims 1-4, 15-18, 22-25, and 29 are considered on the merits. The traversal is on the ground(s) that the examination of all of the claims can be made without serious burden. This is not found persuasive because the different species presented in this application each include unique features that require an individual focus during search and examination. The individual attention demanded of each variance of the invention indeed creates a serious burden.

The requirement is still deemed proper and is therefore made FINAL.

### ***Information Disclosure Statement***

The information disclosure statement (IDS) submitted on April 12, 2002 has been considered by the examiner.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 15, 16, and 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson US 5,924,704 in view of Moore US 5,873,583.

Johnson discloses an in-line roller skate having a boot 5, a frame formed by the base of the boot shell and bracket 4, a plurality of skating wheels 1 and 3 rotatably mounted on the frame, a counter-rotatable braking device 6 rotatably attached to the frame, and a braking wheel 2 rotatably attached to the frame. The braking device includes means 38, 39 to allow rotation of the device in one direction and to resist rotation in the other direction. Also, the braking device is mounted on an axle 10 that is fixedly attached to the frame through mechanism 7 and 15, which allows for adjustment but maintains a fixed attachment at each position set by an operator. The braking wheel is attached to the frame by means for mounting the braking wheel in contact with the braking device at least when the skate is tilted, wherein the mounting means comprises a mechanism for slidably attaching an axle to the frame that allows displacement of the axle in an upward direction. This mechanism comprises a pair of parallel elongated slots in the frame, which accommodate insert 23, with an axle slidably mounted in the slots.

The contact point between the braking wheel and the braking device is approximately vertically above the contact point between the braking wheel and the skating surface when the skating wheel adjacent to the braking wheel and the braking wheel are both in contact with the skating surface. The braking device is oriented to allow rotation of the braking wheel against the skating surface in the forward skating direction and to resist rotation of the braking wheel against the skating surface in the

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reverse direction. Also, the counter-rotatable breaking device, the breaking wheel and the skating wheels are in a common plane of rotation. See Figures 2 and 6A-6C; column 3, lines 34-39; and column 4, lines 1-39.

Johnson discloses the braking device and braking wheel at the rear end of the frame, rather than the claimed forward end. However, Moore teaches that the practice of arranging a braking device 33 and braking wheel 32 at the forward end of a skate frame was old and well known in the art at the time the invention was made. See Figures 1-3. From the teachings of Moore, arranging the braking device and braking wheel of Johnson at the forward end of the frame, rather than the rear end, would have been obvious to one of ordinary skill in the art at the time the invention was made. This would assist the operator in starting and accelerating. Also, the method of claims 15, 16, and 22-25 is directed to the method of operating the skate of Johnson, as modified by Moore.

Claims 3, 4, 17, 18, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson US 5,924,704 in view of Moore US 5,873,583 as applied to claims 1, 2, 15, 16, and 22-25 above, and further in view of Riutta US 5,192,099.

Johnson does not disclose that the long axes of the slots are inclined rearward approximately ten degrees from vertical. However, Riutta teaches the old and well known practice of arranging slots 56 on a skate frame at a rearward incline. See Figure 4 and also see slot 38 in Figure 5. From the teaching of Riutta, arranging the slots of Johnson at a rearward incline would have been obvious to one of ordinary skill in the art

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at the time the invention was made. This would improve the efficiency of the brake device of Johnson by maintaining more direct alignment between the sliding motion of the braking wheel and the braking device when the skate is oriented at an angle during a forward skating motion. This modification would necessarily result in the braking device of Johnson being approximately in line with the axes of the slots, as defined in claim 29.

Moreover, the depiction of slots 56 and 38 in Figures 4 and 5 of Riutta suggest that the slots are oriented approximately ten degrees from vertical. From this teaching of Riutta, orienting the slots of Johnson approximately ten degrees from vertical would have been obvious so that the incline of the slots would be oriented for optimum efficiency when the skate is at an angle during a forward skating motion. Also, the claimed range of approximately ten degrees does not distinguish over the prior art because the claimed range and the range of Riutta overlap, or at least are close enough that one of ordinary skill in the art would have expected them to have the same properties. See *Titanium Metals Corp. of America v. Banner*, 227 USPQ 773 (Fed. Cir. 1985).

### **Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ferris, Ryan et al., Chase, Malewicz, Hoskin, Haldemann, Gignoux et al., Gignoux, Ross, Moe, Repucci, and Holland disclose roller skates.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher Bottorff whose telephone number is (703) 308-2183. The examiner can normally be reached on Mon.-Fri. 7:30 a.m. - 4:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Johnson can be reached on (703) 308-0885. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.



Christopher Bottorff  
May 29, 2003